

REMARKS

Applicant appreciates the thorough examination of the present application as evidenced by the Office Action of June 5, 2008. Applicant respectfully submits that the pending claims are patentable over the cited references for at least the reasons discussed herein.

The Section 112 Rejections

A. Claims 10 and 12-13 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. *See* Office Action, page 2. The Office Action states:

...Claims 10 and 12-13 are drawn to any "data processor", regardless of construct, that performs the function recited...Thus, claims 10 and 12-13 yield a "data processor" that achieves a result without defining what will do so.

See Office Action, page 7. Applicant respectfully disagrees. Claim 10 recites:

A calculator for estimating a cost savings attributable to use of a backup power system, comprising a **data processor configured to obtain historical power status information relating to operation of a UPS in the backup power system and compute an estimate of cost savings for the UPS from the obtained historical power status information.**

Thus, the data processor recited in Claim 10 is not a generic data processor as suggested in the Office Action, it is a data processor configured to perform functions in accordance with embodiments of the present invention. Applicant respectfully submits that the recitations of Claims 10 and 12-13 comply with the enablement requirement of section 112 for at least the reasons discussed herein.

B. Claims are rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. *See* Office Action, page 3. In particular, the Office Action points to the recitations of Claim 3 as being omitted. *See* Office Action, page 3. Applicant would like to point out that no claims are specified in the rejection and, thus, it is very difficult to respond to such a rejection. Generically speaking, the recitations of Claim 3 set out in the Office Action recite additional

information that may be obtained in accordance with some embodiments of the present invention, but do not recite essential steps as suggested in the Office Action. Applicant respectfully submits that the pending claims all include the steps necessary. If the present rejection is maintained in a subsequent action, Applicant respectfully requests that any subsequent action indicate which claims are being rejected and further explain why these claims are considered as having omitted essential steps.

The Section 103 Rejections

A. Claims 1-2, 5, 8, 10, 12, 14-15, 18 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent Publication No. 2003/032949 to Fallon (hereinafter "Fallon") in view of "Cash flow, Energy Performance, and Environmental Protection, What's the Link? ENERGY STAR" (hereinafter "ENERGY STAR"). *See* Office Action, page 4. Applicant respectfully submits that many of the recitations of Claim 1 are neither disclosed nor suggested by the cited combination for at least the reasons discussed herein. For example, Claim 1 recites:

A method of estimating a cost savings attributable to use of a UPS in a backup power system, the method comprising the following steps implemented in a data processing system:

obtaining historical power status information relating to operation of the UPS in the backup power system; and
computing an estimate of cost savings for the UPS from the obtained historical power status information.

Independent Claims 10 and 14 contain corresponding calculator and computer program product recitations, respectively. Applicant respectfully submits that at least the highlighted recitations of Claim 1 are neither disclosed nor suggested by the cited combination for at least the reasons discussed herein.

The Office Action states that Fallon teaches all the recitations of Claim 1 except "computing an estimate of cost savings from the obtained historical power status information." *See* Office Action, page 4. However, the Office Action points to ENERGY STAR as providing the missing teachings. *See* Office Action, page 4. Applicant respectfully submits that the combination of Fallon and ENERGY STAR does not disclose or suggest the

recitations of Claim 1 and that there is no motivation to combine Fallon and ENERGY STAR as suggested in the Office Action for at least the reasons discussed herein.

Fallon discusses a user interface providing UPS information as recited in the title. As discussed in Fallon:

[0108] In at least some embodiments of the invention, parts of the software application 70 can track information about the events that occur, to provide further information to a user and/or to the manufacturer(s) of the UPS 50 and/or the software application 70. For example, in at least one embodiment of the invention, the event notifier 130 also provides information for an event log. The worker module 100 maintains a log of all events generated by the UPS 50 as well some events associated with the software application. The event log includes the date, time and description of the event.

[0109] The events that are logged are used to generate information and reports about the performance of the UPS 50 and can be used for other aspects of the software application 70. Representative examples of events that can be logged include blackout, undervoltage, overvoltage, sensitivity fluctuation, self-test with result, worksafe condition, shutdown, hibernation, and online (the latter can be used to determine how long the UPS 50 was on battery due to a power event).

FIG. 10 is an illustrative representative screen shot illustrating a performance summary report 400 based on events that the software application 70 logged over a time period., which may include information such as when the battery backup last intervened, the period of time the battery backup was in use, how many times battery backup power has been used and the like.

See Fallon, Figure 10 and paragraphs 108 and 109 (emphasis added). In other words, Fallon discusses tracking information associated with a UPS and generating reports including the tracked information. Figure 10 of Fallon illustrates an exemplary report generated using the systems/methods of Fallon. The teachings of Fallon are limited to providing information with respect to one or more UPSs in a user friendly manner. Nothing in Fallon discloses or suggests using the obtained information relating to operation of a UPS to compute an estimate of cost savings for a particular UPS as recited in Claim 1 of the present application. ENERGY STAR does not provide the missing teachings. In particular, ENERGY STAR discusses a Cash Flow Opportunity calculator (CFO Calculator) to help decisionmakers decide whether or not to replace their existing equipment with equipment having an ENERGY STAR rating. In other words, the CFO Calculator helps a decisionmaker to determine if the cost of the ENERGY STAR equipment will be offset by the savings it would provide. As discussed in ENERGY STAR, the user can choose to use "best estimates of how

your building operates and how much better it could operate" or "data generated when you use ENERGY STAR's portfolio manager." In stark contrast, Claim 1 recites computing an estimate of cost savings for a single UPS from obtained historical power status information. In other words, embodiments of the present invention provide information as to whether a particular UPS is saving money for the company. Applicant admits that ENERGY STAR discusses cost savings provided by ENERGY STAR equipment, however, nothing in ENERGY STAR discloses or suggests computing an estimate of cost savings for the UPS from the obtained historical power status information as recited in Claim 1.

Accordingly, Applicant respectfully submits that the cited combination does not disclose or suggest computing an estimate of cost savings for the UPS from the obtained historical power status information as recited in Claim 1 for at least the reasons discussed herein. Furthermore, Applicant respectfully submits that one of skill in the art would not be motivated to combine the cited references as suggested in the Office Action. In particular, the Office Action states:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Fallon et al. to include the feature of "ENERGYSTAR®" in order to inform the user of a cost savings realized through the use of such a device.

See Office Action, page 4. Applicant respectfully submits that the motivation provided in the Office Action is not adequate to sustain the Office's burden under section 103. The Office cannot just use Applicant's disclosure to locate the individual recitations of the claims in multiple references and then conclude that it would have been obvious to combine the references to teach the claims as a whole. If this were allowed, then every claim would be rendered obvious. The motivation must be present in the references or in the art without using Applicant's disclosure as a road map. If the motivation provided in the Office Action were adequate to sustain the Office's burden, then anything that "would inform the user of a cost savings" would render a combination obvious. This cannot be the case.

Furthermore, even if combined, the combination does not disclose or suggest computing an estimate of cost savings from the obtained historical power status information as recited in Claim 1. The combination of Fallon and ENERGY STAR teaches a system for collecting information related to the operation of a UPS, presenting this information in a user friendly manner and calculating cost vs. savings of ENERGY STAR equipment. Nothing in

the cited combination discloses or suggests provision of a cost estimate for a particular UPS as recited in Claim 1 of the present application.

Accordingly, Applicant respectfully submits that Claims 1, 10 and 14 and the claims that depend therefrom are patentable over the cited combination for at least the reasons discussed above. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejections with respect to these claims.

B. Claims 3-4, 9, 13, 16-17 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fallon, in further view of ENERGY STAR, and in still further view of United States Patent No. 6,411,910 to Eulau (hereinafter "Eulau"). *See* Office Action, page 6. Although Claims 7, 11 and 20 are not specifically set out in the rejection based on Fallon, ENERGY STAR and Eulau, these claims are discussed in the text of the rejection on pages 8-10 and, thus, Applicant will discuss the rejection of these claims with Claims 3-4, 9, 13, 16-17 and 22 specifically set out in the rejection. Applicant respectfully disagrees that these claims are obvious in view of the cited references. For example, independent Claim 7 recites:

A method of estimating cost savings attributable to use of a UPS in a backup power system, the method comprising the following steps implemented on a data processing system:
receiving historical power status information from the UPS over a communications link;
accepting a power outage cost factor from a user interface;
computing an estimate of cost savings for the UPS based on the historical power status information and the power outage cost factor; and
displaying the estimate of cost savings for the UPS on the user interface.

Independent Claim 20 contains corresponding computer program product recitations. Applicant respectfully submits that at least the highlighted recitations of Claim 7 are neither disclosed nor suggested by the cited combination for at least the reasons discussed herein.

In particular, the Office Action states that Fallon teaches all the recitations of Claim 7 except "accepting a power outage cost factor from a user interface and computing an estimate of cost savings based on the historical power status information and the power outage cost factor." *See* Office Action, page 8. However, the Office Action points to Eulau as providing the missing teachings. *See* Office Action, pages 8-9. Applicant respectfully submits that the

combination of Fallon, ENERGY STAR and Eulau does not disclose or suggest the recitations of Claim 7 and that there is no motivation to combine Fallon, ENERGY STAR and Eulau as suggested in the Office Action for at least the reasons discussed above with respect to Claim 1.

Accordingly, Applicant respectfully submits that Claims 7 and 20 and the claims that depend therefrom are patentable over the cited combination for at least the reasons discussed above. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejections with respect to these claims.

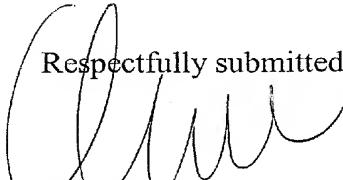
Many of the Dependent Claims are Separately Patentable over the cited combination

As discussed above, the dependent claims are patentable over the cited references at least per the patentability of the independent base claims from which they depend. However, many of the dependent claims are also separately patentable over the cited combination.

For example, dependent Claims 4, 9, 13, 17 and 22 recite the details of computing an estimate of cost savings for a UPS based on obtained historical power status information. As discussed above, nothing in the cited combination discloses or suggests computing a cost estimate based on historical data. Thus, it follows that nothing in the cited references disclose or suggest the details thereof. Accordingly, Applicant respectfully submits that dependent Claims 4, 9, 13, 17 and 22 are patentable over the cited references for at least these additional reasons.

CONCLUSION

In light of the above discussion, Applicant submits that the present application is in condition for allowance, which action is respectfully requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (919) 854-1400.

Respectfully submitted,

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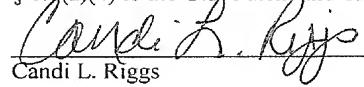
In re: Marcus A. Maxwell
Serial No.: 10/701,850
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